



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/400,170 | 09/21/1999 | BRIAN R. MCCARTHY | 310048-480 | 3096 |

7590 10/01/2003

Douglas N Larson Esq
SQUIRE SANDERS & DEMPSEY LLP
801 S Figueroa St 14th Floor
Los Angeles, CA 90017-5554

26
EXAMINER

GRAY, LINDA LAMEY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1734

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/400,170

Applicant(s)

MCCARTHY ET AL.

Examiner

Linda L Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-56, 65-96 and 142-204 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-56, 65-96 and 184-204 is/are allowed.
- 6) ☒ Claim(s) 142-175 and 177-183 is/are rejected.
- 7) ☐ Claim(s) 176 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 23,25
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

Claim Numbering

1. The numbering of claims is not accordance with 37 CFR 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR 1.121(b), they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered claims 145 (second occurrence)-203 have been renumbered as claims 146-204, respectively.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 142-148, 152, 154-175, and 177-182 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (US 5,198,275) in view of Popat et al. (US 5,407,718).**

Claims 142 and 175, Klein teaches a method of forming a sheet of printable media (business cards) (Fig 3) including providing a construction including (a) printable facestock 85, (b) liner 90 having liner coating 125, and (c) ultraremovable adhesive 95 between facestock 85 and coating 125 and thereby adhering liner 90 to facestock 85. The method further includes cutting through facestock 85 to liner 90 to form facestock cut lines 200 defining at least in part perimeters of printable media whose back sides are formed by a back side of facestock 85. Liner 90 covers all the back sides of facestock 85 and holds the media together for a printing operation. The media can be removed from liner 90 after printing to form individual media (c 2, L 39, to c 4, L 24).

Claims 142, Klein does not teach that liner 90 is a solid liner.

Popat et al. teach a plurality of printable media 22 on solid liner 28.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that liner 90 is a solid liner without the cut lines because Popat et al. teach solid liners to be conventional when individual cards are not desired to be separated completely from the construction and one skilled in the art not wishing to have a completely separated piece from the construction of Klein would have been motivated to eliminate cut lines 300 to provide a solid liner in that Popat et al. provide the necessary guidance for using solid liners in the printable media art.

Claims 143-146, Klein does not teach a liner primer of polyvinyl alcohol with silicate.

However, liner primers are conventional in the art to prepare the liner for contact with another surface, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein a liner primer on liner 90 of polyvinyl alcohol base with silicate.

Claims 147-148, adhesive 95 covers the entire back side of facestock 85 and the entire front side of liner 90. **Claim 152**, liner 90 is a paper sheet. **Claims 154-155, 161, 175, and 181-182**, the cardstock can be cut into individual sheets after lines 200 are formed with a plurality of printable media per sheet. **Claim 156**, facestock 85 is a sheet and lines 200 include horizontal cut lines that extend a full width of the sheet.

Claims 157 and 175, Klein does not teach unwinding from a roll.

It is conventional to provide a supply of label material from a roll because such is an efficient means for storing a large quantity of material, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein unwinding from a roll.

Claim 158, facestock 85 includes a cardstock sheet, and liner 90 is a paper sheet. **Claims 159 and 182**, there is provided a matrix of business cards including a pair of directly adjacent columns and a plurality of rows. **Claims 160 and 180**, the printable media are in a central portion surrounded by a facestock waste frame.

***Claim 162**, Klein does not teach specifics about the cutting of lines 200 in that Klein does not teach that cutting is die cutting.*

Die cutting is conventional in the art, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that cutting lines 200 is by die cutting because it is obvious replace one type of cutting with another art recognized alternative type of cutting.

Claim 164-165 and 179, the media are solid cards with no cut lines therein. **Claim 164**, facestock 85 is a sheet, liner 90 is a sheet, and liner 90 extends the entire width and length of facestock 85.

***Claims 166-168**, in Klein the construction in a dual-web. Klein does not teach cutting the finished construction into two webs longitudinally.*

However, it is conventional to cut a web having a plurality of labels thereon into more than one web by cutting such longitudinally, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein cutting the construction into two webs longitudinally.

***Claim 169**, Klein does not teach calendaring for cutting.*

It is known to calendar an endless web to keep tension within the web, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein calendaring the continuous cardstock for cutting.

Claim 170, lines 200 are vertical and horizontal. **Claim 171**, facestock 85 is a cardstock sheet and one of lines 200 extends the full width of facestock 85.

***Claim 172**, Klein does not teach that the rest of horizontal lines 200 are spaced inwardly with the edges.*

It is conventional to provide a small uncut piece of web material and the edges of a group of labels in a sheet to further help keep the labels together until desired to be separated, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that the rest of horizontal lines 200 are spaced inwardly from the edges.

Claims 173, the cardstock can be cut into individual sheets after lines 200 are formed with a plurality of printable media per sheet. **Claim 174**, facestock 85 is a cardstock sheet and liner 90 is a paper sheet.

Claim 177, *Klein does not teach printing before cutting.*

Claim 178, cutting does not penetrate liner 90 from above facestock 85.

However, MPEP § 2144.04 ("Changes in Sequence of Adding Ingredients") indicates that a particular order (i.e., printing before cutting) is prima facie obvious in the absence of new or unexpected results

4. Claims 149-151 and 183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Popat et al. as applied to claims 142-148, 152, 154-175, and 177-182 above, and further in view of Cahill et al. (US 5,766,398).

Claims 149-150 and 183, *Klein does not teach a printer receptive top coating (claim 149) of a laser color-optimizing coating (claim 150) or an ink-jet color optimizing coating (claim 150).*

Cahill et al. teach continuously printing image 18 onto plastic film 14 having coating 16 thereon (c 1, L 29-40; c 2, L 25-44; c 4, L 1-9; c 5, L 1-37; c 7, L 43-44). Coating 16 is a PVA solution intended to be very receptive to the ink of image 18 (c 4, L 4; c 5, L 39, to c 7, L 4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein coating a PVA solution on facestock 85 to receive the print because Cahill et al. teach using such is intended to be very receptive to ink being printed thereon where laser printing and ink jet printing are conventional in the card making art.

Claim 151, the media are held together as a sheet during printing.

5. Claim 153 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of P. et al. as applied to claims 142-148, 152, 154-175, and 177-182 above, and further in view of Mallya et al. (US 5,656,705).

Claim 153, Klein does not teach adhesive 95 to be a water-base acrylic suspension polymer.

Mallya et al. teach this adhesive, i.e. a water-bases acrylic suspension polymer adhesive, is conventionally used in to production of repositionable labels (c 1, L 1-6).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that adhesive 95 is a water-based acrylic suspension polymer because Mallya et al. teach this adhesive, i.e. a water-bases acrylic suspension polymer adhesive, is conventionally used in to production of repositionable labels and it is obvious to place one adhesive with another art recognized alternative adhesive used in the same art

Allowable Subject Matter

6. Claims 43-56, 65-96, and 184-204 are allowed.

Claim 176 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: claim 176, in Klein the printable media do not define a matrix of rectangular business cards including a plurality of rows and columns of the cards with the cards of each directly abutting cards of adjacent rows and columns separated only by lines 200 in that there is waste web of facestock 85 therebetween.

8. As allowable subject matter has been indicated, Applicants' reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).


Response to Amendment

9. Applicants' comments filed 7-25-03 have been fully considered. Applicants indicate that Klein does not teach a solid carrier. In response, Popat et al. was applied in combination with Klein to meet this limitation.

Conclusion

10. Any inquiry concerning this communication or earlier communications should be directed to Examiner Linda L. Gray at (703) 308-1093, Monday-Friday from 6:30 am to 3:30 pm. The necessary fax numbers are (703) 872-9310 and (703) 872-9311.

llg 
September 30, 2003


LINDA GRAY
PRIMARY EXAMINER